

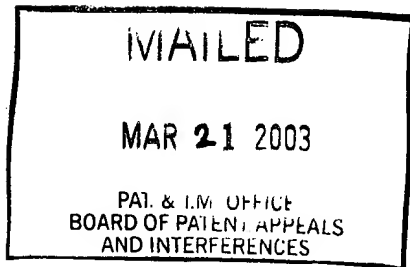
The opinion in support of the decision being entered today was ~~not~~ written for publication and is ~~not~~ binding precedent of the Board.

Paper No. 18

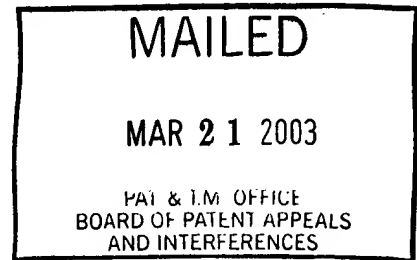
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* JOHN F. BREEDIS, RONALD N. CARON  
and  
CARL L. DEPPISH



Appeal No. 2002-0969  
Application No. 09/192,766



ON BRIEF

Before WARREN, OWENS, and TIMM, *Administrative Patent Judges*.  
TIMM, *Administrative Patent Judge*.

***ON REMAND TO THE EXAMINER***

A review of the record presently before us leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the Examiner, via the Office of a Director of the involved Technology Center, to consider the following issues and to take action not inconsistent with the views expressed herein.

### ***DISCUSSION***

The duty of the Board is to review, on written appeal of an applicant, the adverse decisions of examiners upon applications for patents. 35 U.S.C. § 6(b)(2000). In order for an appellate body “to fulfill its role of judicial review, it must have a clear understanding of the grounds for the decision being reviewed.” *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1033 (Fed. Cir. 1997). The examiner must therefore present adequate findings of fact and those findings must be expressed on the written record with sufficient particularity to enable the appellate body, without resort to speculation, to understand the reasoning of the examiner and to determine if the examiner applied the law correctly and whether the evidence supports the underlying and ultimate fact findings. *Id.*

In the present case, the Examiner has failed to express adequate findings of fact on the record in such a way for us to understand the Examiner’s reasoning. The deficiency results from the method by which the Examiner grouped and discussed the large number of rejections advanced in the Answer. Even though the Examiner has grouped many of the rejections together, there are, in reality, eleven different grounds of rejection. Rather than go to the trouble of explaining each ground separately, the Examiner discusses all the references and rejections together in two paragraphs. Instead of identifying specific references, the Examiner makes statements such as “[s]ome references do not disclose the claimed Ni to P ratio” and “some references may contain additional optional alloying element.” The Examiner’s broad brush does not paint a sufficiently

detailed picture to enable us to determine what specific evidence the Examiner is relying upon in any given reference in order to support a conclusion of obviousness. For each rejection the Examiner maintains, the Examiner must present findings of fact in such a way that we can determine what portion of any given reference is being relied upon. The Examiner must also reasonably associate each reference with the conclusion of obviousness to be drawn therefrom. We remand for that purpose.

We further remand to the Examiner for consideration of whether one or more of the claims are anticipated under 35 U.S.C. § 102 by any of the prior art references. “The patent law imposes certain fundamental conditions for patentability, paramount among them being the condition that what is sought to be patented, as determined by the claims, be new.” *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 780, 227 USPQ 773, 777 (Fed. Cir. 1985). Claim 1 is directed to an alloy composition. Therefore, if the alloy *composition* is not new, it is not patentable.

Particularly, there is a question as to whether the alloy of claim 1 is new in view of the disclosure of sample no. 14 listed in Table 1 of JP 5-311,292. “[W]hen, as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is ‘anticipated’ if *one* of them is in the prior art.” *Id.*; *See also In re Gosteli*, 872 F.2d 1008, 1010, 10 USPQ2d 1614, 1616 (Fed. Cir. 1989); *In re Slayter*, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960). The copper base alloy composition of sample no. 14 contains 15.8 wt % zinc (Zn), 0.37 wt % Nickel (Ni), 0.40 wt % Tin (Sn), and 0.05 wt % phosphorous (P). Furthermore, the alloy has a Ni/P ratio of 7.4. The alloy

contains no silicon or beryllium and, therefore, has less than 0.1 % each of these elements as required by the claim. The alloy composition is squarely within the ranges set forth in claim 1.

Claim 1 also recites that the alloy has an electrical conductivity in excess of 25% IACS and is suitable for forming into an electrical connector. JP '292 does not set forth the electrical conductivity of the composition nor does it disclose whether the alloy is suitable for forming into an electrical connector. But that does not necessarily mean there is a patentable difference in composition. "The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from the prior art, can not impart patentability to claims to the known composition." *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990). The Examiner should consider the question of whether there is a reasonable basis to believe that conductivity in excess of 25% IACS is an inherent property of the composition of sample no. 14. *See Id.*; *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433-34 (CCPA 1977); *In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82-83 (CCPA 1975). If so, the Examiner should reject the appropriate claims under 35 U.S.C. § 102.

Appellants argue that sample no. 14 is a comparative example which the reference teaches as having inferior characteristics (Reply Brief at 5) and that Appellants have shown unexpected results (Brief at 4-7). We note that "[a] reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. Thus, the question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis." *Celeritas Techs., Ltd. v. Rockwell Int'l Corp.*,

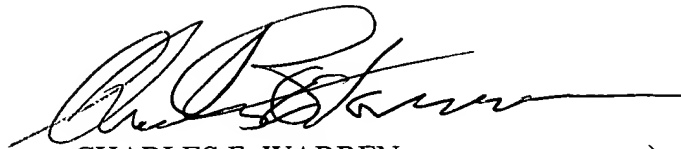
150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998). We also note that evidence of unexpected results is relevant to obviousness but not anticipation. *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

### ***CONCLUSION***

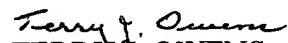
In summary, the instant application is remanded to the Examiner to consider the aforementioned issues and to act accordingly.

This application, by virtue of its "special" status requires an immediate action. *MPEP* § 708.01(d) (8<sup>th</sup> ed., Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case (e.g., abandonment, issue, reopening prosecution). An appeal conference as mandated by *MPEP* § 1208 (8<sup>th</sup> ed., Aug. 2001) must be held before this case is subject to further appeal proceedings.

REMANDED



CHARLES F. WARREN  
Administrative Patent Judge

  
TERRY J. OWENS

Administrative Patent Judge



CATHERINE TIMM  
Administrative Patent Judge

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